

## REMARKS/ARGUMENTS

### Brief Summary of Office Action

In the above-mentioned Office Action, claims 78-87, 89-103, 105-119, 121-135 and 137-142 were rejected as anticipated by *Cancio* (U.S. Patents 4,380,564 or 4,465,729), and claims 1 [sic -78]-142 were rejected as being unpatentable over *Cancio* in view of *Kishimoto* (5,560,966). In response thereto new independent claims 143-147 have been added. Also, dependent claims 84, 100, 116 and 132 have been cancelled since they are duplicates of claims 81, 97, 113 and 129, respectively.

### Patentability of Pending Independent Claims

Pending independent claims 78, 94, 110, 126, and 142 (and the claims depending therefrom) are all directed to sheet structures having first and second layers. A plurality of continuous cut lines are cut completely through the first layer and define a plurality of sheet portions of the sheet. At least one of the first and second layers is selected and constructed and the cut lines are configured such that the sheet can be bent upwardly and/or downwardly along at least some of the cut lines to thereby be split along at least some of the cut lines and separate the sheet portions from the sheet into a plurality of individual sheet portions.

The limitations on the first and second layers and the cut lines as set forth in claims 78, 94, 110, 126 and 142 and discussed in the paragraph above (whereby the sheet can be bent upwardly and/or downwardly along the cut lines to thereby be split) are positive structural limitations, Applicant respectfully contends.

*Ex parte Masham*, 2 USPQ2d 1648 (Bd. Pat. App. & Inter., 1987), cited by the examiner is not on point for the examiner's argument that the "phrases" at issue in the rejected claims are to be given no patentable weight. *Masham* deals with the relationship of a claim element (mixing means) and a working environment (developer material) of that element. In contrast, the phrases in the claims of the present invention concern physical relationships of the claim elements (e.g., first and second layers and cut lines) and physical properties of the sheet structure itself. They are not concerned

with the physical relationship of any of the elements with a working environmental object, such as the claimed multi-layer sheet being positioned in an "envelope."

Cancio discloses a cross-tearable plastic film. The plastic film has a fine grid of embossed hand-tear lines formed in the surface of the film whereby the film may be torn by hand in more than one direction. The film is torn with an action as shown in FIG. 1 of the '729 Cancio patent. Cancio does not disclose that its plastic film is (or can be) bent backwardly and/or forwardly to split and separate the plastic film into small sheetportions.

Referring to column 4, line 55, of the '564 Cancio patent, an embodiment is described wherein the layer is extruded onto paper (line 65). According to this invention, the extruded layer is "thinned" by embossing, allowing the composite to be tearable. This embodiment does not break when folded. The paper simply folds. In fact, bending it back and forth multiple times will not cause it to break any more than folding paper back and forth causes the paper to break. In order to separate the two portions, the material must be torn, or in other words be pulled in opposite directions. This is because Cancio places his weakened lines in the filmic layer in order to obtain the desirable tearable properties. By describing an extrusion-coated paper Cancio demonstrates that the separation mechanism takes place not only in the invented material, but also any laminate that may be associated therewith.

Additionally, Cancio does not disclose cut lines which penetrate and are cut completely through a layer. Rather, Cancio discloses embossed lines which crush the top surface of the film and do not cut or penetrate the top surface, as shown in FIG. 2.

In fact, one would not want to cut Cancio completely through the film layer. The function of a shelf paper such as that of Cancio, includes that of a barrier to prohibit penetration of liquids, such as cooking oils, etc., into a substrate. A contiguous film would accomplish this purpose. However, a cut through the film layer to a paper layer would permit wicking of a liquid into the paper layer and ultimately into the substrate the shelf paper is covering.

According to one use of the Cancio plastic film, the shelf liner of Cancio is laid on a shelf with only a portion of the adhesive exposed. The liner is then removed from underneath while smoothing the shelf liner. In other words, FIG. 1 of the '564 Cancio patent shows the invention being used to line both the top surface and front surface of a shelf, by reference numeral 36, for example. In contrast, the layers of the sheet structure of the present invention do not peel apart. For the sake of argument, if one did remove a bottom layer of a sheet structure of the present invention and somehow or other folded the rest of the sheet structure around a shelf edge and attached it to shelf top and bottom sides, the cut lines would either cause the structure collect dirt or liquid or to fall apart.

#### Patentability of New Independent Claims

The new claims (claims 143-147) use the descriptive phrase "adapted to." Language in the body of the claim following the description phrase "adapted to" is a structural limitation, as a matter of law. For example, in *In re Venezia*, 189 USPQ 149 (CCPA 1976), some of the claim language at issue was "a pair of elastic sleeves ... adapted to be fitted over the insulating jacket of one of said cables." *Id.* at 150. Concerning the above quoted aspect of the claim, the CCPA stated that: "[r]ather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so constructed or dimensioned that it can be fitted over the insulating jacket of the cable." *Id.* at 959, 189 USPQ at 151-152, emphasis added. (See also *In re Barr*, 444 F.2d 588, 170 USPQ330 (CCPA 1971).)

It is also well-settled that all limitations must be considered in a patentability determination and that it is improper to ignore specific limitations in the claim that distinguish over the cited references. See, e.g., *In re Boe and Duke*, 505 F.2d 1297, 1299, 184 USPQ 38, 40 (CCPA 1974). Accordingly, Applicant respectfully submits that respective portions of the claims that follow the descriptive phrase "adapted to" are structural limitations that must be accorded the same weight as any other limitations recited in the body of the claim.

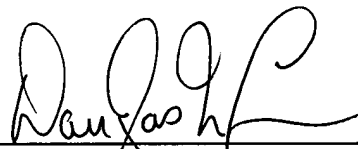
In addition to these structural limitations, the "cut lines" in these new claims are not disclosed by the prior art, as discussed previously.

Concluding Remarks

It is thus respectfully submitted that the subject application is in condition for allowance. If there are any remaining issues, the Examiner is encouraged to telephone the below-signed counsel at (213) 689-5142 to seek to resolve them.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1853. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,



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